REMARKS

Claims 1-14 are pending in the present application. Claims 1, 7, and 10 are amended. Reconsideration of the claims is respectfully requested.

I. Application to be Considered Special

This application has received a fourth **non-final** Office Action after being withdrawn from appeal. As per MPEP § 707.02, Applicants respectfully request that the **Supervisory Patent Examiner** personally check on the pendency of this application and make every effort to terminate prosecution. Applicants request the Examiner and the Examiner's Supervisory Patent Examiner call the undersigned at the below-listed telephone number to discuss a course of action that may result in termination of prosecution.

II. 35 U.S.C. § 101

The Office Action rejects claims 1-9 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. Independent claim 1 is amended as suggested by the Examiner. Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-9 under 35 U.S.C. § 101.

III. 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claims 1-14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. This rejection is respectfully traversed.

With respect to claims 1-9, the claims are amended to more clearly recite statutory subject matter.

With respect to claim 4, Applicants submit that the language "wherein the given action is selected from the actions consisting essentially of" is definite and unambiguous. Clearly, this language further limits **the** given action earlier presented in claim 3, on which claim 4 depends.

With respect to claim 8, the Office Alleges that it is unclear what is a "fuzzy match." Fuzzy matching is a well-known technique of which a person of ordinary skill in

the art would be well aware. Applicants respectfully submit that the phrase "fuzzy match" would not be unclear to a person of ordinary skill in the art. Webster's New World Computer Dictionary, 10th Edition defines "fuzzy logic" as follows:

> **fuzzy logic** A branch of logic that involves logical problems to be investigated and solved even though some of the values cannot be specified as absolutely true or absolutely false. Fuzzy logic has been used to implement artificial intelligence and advanced control systems for high-speed railways.

Thus, a person of ordinary skill in field of the invention would see that a "fuzzy match" is a match that is based on values that cannot be specified as absolutely true or absolutely false. Furthermore, U.S. Patent No. 5,214,653 to Elliott Jr. et al., filed on October 22, 1990, states:

> The inference process, in the illustrated embodiment, uses "fuzzy matching", a well-known technique of matching, for comparing the input data, the premises and the conclusions.

Elliott Jr. et al., col. 4, line 67, to col. 5, line 2. Clearly, the term "fuzzy match" recited in claim 8 would be readily known to persons of routine skill in the art.

With respect to claim 6, the Office Action alleges that the language "wherein the profile includes matching criteria" is indefinite because it is unclear whether the language should be interpreted to mean "in addition to" or "in replacement of" the phrase "generating a profile." Applicants submit that the language shall be interpreted to mean that the profile is further limited as including matching criteria, just as recited in the claim. Giving the words their plain and accepted meanings, claim 6 is definite and unambiguous. Claims 7 and 8 clearly and unambiguously further define the matching criteria earlier presented in claim 6 from which they depend. The Office Action gives no specific grounds for rejecting claim 9 under 35 U.S.C. § 112, second paragraph.

Claim 10 is amended to more clearly recite the subject matter that Applicants regard as the invention.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-14 under 35 U.S.C. § 112, second paragraph.

IV. 35 U.S.C. § 102, Alleged Anticipation of claims 1-14

The Office Action rejects claims 1-14 under 35 U.S.C. § 102 (e) as being allegedly anticipated by Streetprices.com (website printout of January 25, 1999) and under 35 U.S.C. § 102 (b) based upon a public use or sale of Streetrpices.com. This rejection is respectfully traversed.

The Office Action states:

> Claims 1-14, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Streetprices.com (website printout of January 25, 1999) ("Streetprices 1/99"). Streetprices 1/99 discloses generating a set of product profiles (see *e.g.* "Computers", "Flowers" and "Toys"), each identifying a given site URL (inherent); a list of one or more included items to be queried (the product to be searched), a scan interval (inherent in the graphs) and a site template (inherent in HTML and XML; periodically retrieving data from the given site URL (inherent in the x axis of the graph) according to the scan interval; parsing the data retrieved to generate a data record (inherent since it discloses the price over time); storing the data records (inherent); and the product profiles includes one or more triggers (a threshold price which sends an email when a price drops below a particular level).
>
> Claims 1-14 are alternatively rejected under 35 U.S.C. §102(b) based upon a public use or sale of the invention. In this case, evidence to support the public use is the StreetPrices.com website. See the additional cited StreetPrices.com printouts noted in the previous office actions (Paper No. 9, Paragraph No. 20).

Office Action dated September 30, 2004. Applicants respectfully disagree. The streetprices.com Web site does not explicitly or inherently teach the features of the presently claimed invention and, thus, does not anticipate the claimed invention.

The streetprices.com Web site is clearly an HTTP server or, in other words, a Web site that is embodied on a server. From the teachings of the streetprices.com references, a person of ordinary skill in the art will recognize that the streetprices.com Web site or HTTP server receives a search query identifying a given product, obtains prices for the given product from selected e-commerce Web sites, and generates a return HTML document that presents the identified prices for the given product. Thus, the streetprices.com Web server performs the functions of the Web site, generates Web pages, and returns these pages to the client. As a person of ordinary skill in the art would instantly recognize, a browser client application on a client computer may request HTML

Web pages from the streetprices.com Web site. The only functions being performed at the client computer are requesting HTML documents, rendering HTML documents, displaying HTML documents, and, responsive to a user selecting a link in an HTML document, requesting further HTML documents.

In contradistinction, the present invention provides a method and computer program product at a client computer for collecting product data. Claim 1 recites:

> 1. A method **in a client computer** for collecting product data, comprising the computer implemented steps of:
> generating, **at the client computer**, a profile identifying a given site URL, an item to be queried, and a scan interval;
> on a periodic basis as defined by the scan interval, retrieving data from the given site URL **to the client computer**;
> parsing, **at the client computer**, the retrieved data according to a site template; and
> generating a data record **at the client computer** including an item name and an associated price value. [emphasis added]

Claim 10 recites:

> 10. A method, **in a client computer**, of collecting product data, comprising the steps of:
> generating a set of product profiles **at the client computer**, wherein each product profile within the set of product profiles identifies a given site URL, a list of one or more included items to be queried, a scan interval, and a site template;
> for a given product profile, periodically retrieving data from the given site URL **to the client computer** according to the scan interval;
> parsing, **at the client computer**, the data retrieved from the given site URL according to the site template to generate a data record for each included item comprising an item name, an associated price value, and a secondary source; and
> storing the data records **at the client computer**. [emphasis added]

Implementing the functions of the claimed invention in a client computer presents several advantages. When a user generates a set of product profiles at a client computer, the user has much more control over the collection of product data. By generating the set of product profiles in the client computer, the user is able to designate a given site URL to be searched. That is, the user need not rely on a Web service to work out an agreement with e-commerce Web sites; the user may use any Web site he or she desires, as long as a URL is known for the given site.

Furthermore, the user may define a scan interval in the product profiles and have the client-side agent perform the search according to the scan interval defined by the user. Thus, the user has much more control over how often the product data collection is performed. On the other hand, with the streetprices.com Web site, the user is restricted to the scan interval rigidly defined at the Web server.

Moreover, the user need not depend upon a single Web server for operation. That is, if the streetprices.com Web site is not operational, then the user is not able to collect product data. In addition, the streetprices.com Web server may perform product data collection for thousands, even millions, of users. Thus, the performance of the streetprices.com Web server may be degraded during peak usage. This single point of failure in the prior art is a disadvantage that is overcome by the present invention.

Still further, as recited in claim 10, a user may define in a set of product profiles, a site template that is to be used when parsing the results from a given site. Thus, the user may control how the site is parsed by providing a specific template for the site. On the other hand, with the streetprices.com Web site, the user must rely on whatever parsing mechanisms are employed by the server software.

None of the Streetprices references teaches or suggests a method in **a client computer** for collecting product data, as presented in independent claims 1 and 10. Streetprices is clearly a Web site, which is embodied and executed on a Web **server**. The Web server of the streetprices.com references clearly is not a client computer, as recited in claims 1 and 10, particularly when read in light of the present specification. The Office Action proffers no analysis whatsoever as to why a Web server is somehow a client computer. In fact, the Office Action appears to make no attempt whatsoever to address this limitation.

The Office Action misapplies the concept of "inherent" anticipation. Section 102 of Title 35 deals with novelty and loss of patent rights. Under the principles of inherency, a claim is anticipated if a structure in the prior art **necessarily** functions in accordance with the limitations of a process or method claim. *In re King*, 801 F.2d 1324, 231 U.S.P.Q. 136 (Fed. Cir. 1986). The missing claimed characteristics must be a "natural result" flowing from what is disclosed. *Continental Can Co. v. Monsant Co.*, 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). Unstated elements in a reference

are inherent when they exist as a "matter of scientific fact." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 U.S.P.Q.2d 1057 (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988) and *Hughes Aircraft Co. v. United States*, 8 U.S.P.Q.2d 1580 (Ct. Cl. 1988).

In the present case, the Examiner's assertion that these elements are present can be made only through the use of the Applicants' disclosure as a template to fill in the missing elements. The Office Action does not establish any necessity, natural result, or scientific fact to support a conclusion of inherency. The Office Action merely cites a Web site that is somewhat similar to the client-based invention and simply dismisses all of the claim limitations as inherent.

What is known from the applied references is that streetprices.com allows a user to enter a search term or click on a link for a product, collects price information from other Web sites, and generates a results page that is returned to the client. The streetprices.com references also teach that robots are used to crawl 48 e-commerce web sites. Robots, also referred to as "bots," "software agents," or "traveling programs," as well as crawling, are notoriously well-known in the art. Robots are programs that automatically do some action without user intervention. In the context of a search engine, a robot usually refers to a program that mimics a browser to download Web pages automatically. A spider is a type of robot that will download multiple pages from the same Web site. Crawling refers to the fact that the spider will look for links in the pages it downloads and will "walk" or "crawl" down through a Web site.

There is no evidence in the Streetprices.com references whatsoever that a product profile is generated in a client computer, wherein the product profile includes a URL for a given site, nor does it naturally or necessarily flow from the teachings of the applied references that a product profile is generated. As an alternative possibility not taken straight from the instant claims, the robots may crawl all 48 e-commerce Web sites for every single query. There is no need for a product profile in the streetprices.com Web site. There is also no need for a given site URL to be identified in a product profile, because the streetprices.com Web site collects product information for thousands or more products for thousands or more users, rather than collecting product information for a handful of products from a given site for a single user at a client computer.

The streetprices.com Web site need not collect price data periodically. The streetprices.com Web site may collect data continually and merely record price data based on a date of last change. Alternatively, the streetprices.com Web site may look at a log listing the date of the page that was last scanned and determine whether the page needed to be scanned at all. There certainly is no evidence that a scan interval is included in a product profile generated in a client computer. As an alternative possibility not taken directly from the instant claims, the streetprices.com Web site may collect data according to a scan interval hard coded in the server software.

Furthermore, with respect to independent claim 10, the streetprices.com Web site does not inherently teach that a product profile generated in a client computer includes a site template. As an alternative possibility not gleaned form the presently claimed invention, the server software of the streetprices.com web site may strip the results of all HTML tags and use natural language understanding software to identify prices. The Web site may alternatively use proximity operators hard coded in the server software to identify prices. There is no evidence that generating a product profile in a client computer, wherein the product profile includes a site template, is involved in the constitution or essential character of the streetprices.com Web site.

For the above reasons, Applicants submit that missing elements are not inherently present in the streetprices.com Web site. Thus, the Examiner does not establish a *prima facie* case of anticipation for claims 1 and 10.

Therefore, the Office Action fails to establish a *prima facie* case of anticipation for claims 1 and 10. Since claims 2-9 and 11-14 depend from claims 1 and 10, the same distinctions between Streetprices and the invention recited in claims 1 and 10 apply for these claims. Additionally, claims 2-9 and 11-14 recite other additional combinations of features not suggested by the reference.

Claim 8 recites, "wherein the matching criteria is a fuzzy match"; claim 9 recites, "wherein the data record also includes secondary source information"; claim 11 recites, "wherein the given product profile also includes a list of excluded items"; and, claim 12 recites, "wherein the given product profile also includes a next scan date." The Office Action fails to address these limitations, particularly as allegedly taught or suggested prior to invention by Applicants. Therefore, the Office Action fails to establish a *prima*

facie case of anticipation for these claims. Appellants submit that the streetprices.com does not teach or fairly suggest the features of claims 8, 9, 11, and 12.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-14 under 35 U.S.C. § 102.

The Office Action rejects claims 1-14 under 35 U.S.C. § 102 (e) as being allegedly anticipated by *Bailey et al.* (U.S. Patent No. 6,785,671). This rejection is respectfully traversed.

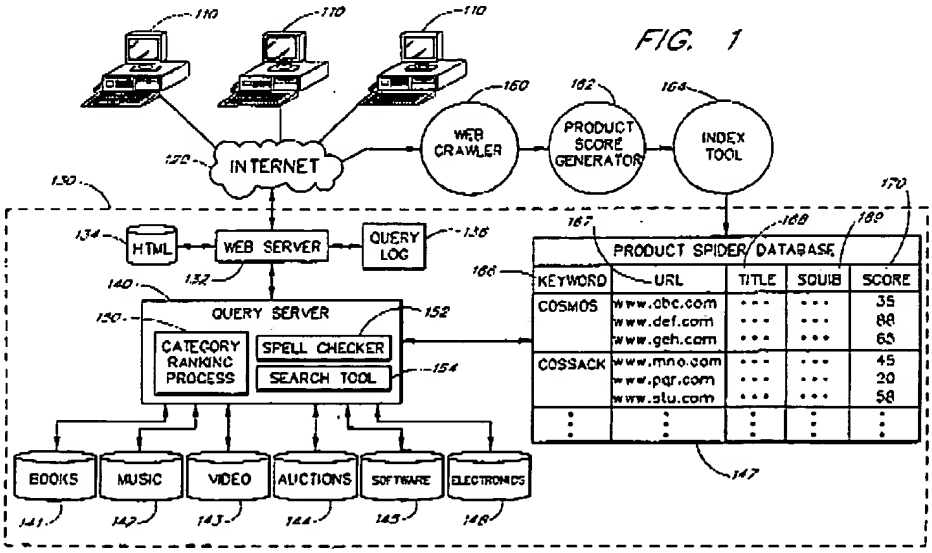
The Office Action states:

> Bailey discloses generating a profile (a product score) identifying a given site URL; an item to be queried, and a scan interval (frequency with which the product spider is refreshed); retrieving data from the URL; parsing the data (extracting the data); storing the data record (inherent); comparing the associated price to a given threshold condition (threshold be the score); taking an action (including the website in the database) if the condition occurs; logging an event (inherent in the recording of events).

Office Action dated September 13, 2004. Applicants respectfully disagree. *Bailey* does not explicitly or inherently teach the features of the presently claimed invention and, thus, does not anticipate the claimed invention.

Bailey suffers from the same deficiencies as the Streetprices.com references. *Bailey* teaches a web site that is embodied on a server. Figure 1 of *Bailey* is as follows:

FIG. 1



Bailey states:

> As shown in FIG. 1, the web site 130 includes a web server application 132 ("web server") that processes user requests received from user computers 110 via the Internet 120. These requests include queries submitted by users to search the on-line catalog for products. The web server 132 records the user transactions, including query submissions, within a query log 136.

Bailey, col. 4, lines 28-34. The Web server of *Bailey* performs the functions of the Web site, generates Web pages, and returns these pages to the client. As a person of ordinary skill in the art would instantly recognize, a browser application on a user computer may request HTML Web pages from the Web site. The only functions being performed at the user computer are requesting HTML documents, rendering HTML documents, displaying HTML documents, and, responsive to a user selecting a link in an HTML document, requesting further HTML documents.

Bailey fails to teach or suggest a method in **a client computer** for collecting product data, as presented in independent claims 1 and 10. *Bailey* clearly teaches a Web site, which is embodied and executed on a Web **server**. The Web server of *Bailey* clearly is not a client computer, as recited in claims 1 and 10, particularly when read in light of the present specification. The Office Action proffers no analysis whatsoever as to why a Web server is somehow a client computer. In fact, the Office Action appears to make no attempt whatsoever to address this limitation.

Again, the Office Action misapplies the concept of "inherent" anticipation. Section 102 of Title 35 deals with novelty and loss of patent rights. Under the principles of inherency, a claim is anticipated if a structure in the prior art **necessarily** functions in accordance with the limitations of a process or method claim. *In re King*, 801 F.2d 1324, 231 U.S.P.Q. 136 (Fed. Cir. 1986). The missing claimed characteristics must be a "natural result" flowing from what is disclosed. *Continental Can Co. v. Monsant Co.*, 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). Unstated elements in a reference are inherent when they exist as a "matter of scientific fact." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 U.S.P.Q.2d 1057 (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988) and *Hughes Aircraft Co. v. United States*, 8 U.S.P.Q.2d 1580 (Ct. Cl. 1988).

The Office Action fails to establish a *prima facie* case of anticipation for claims 1-14. Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-14 under 35 U.S.C. § 102.

V. 35 U.S.C. § 103, Alleged Obviousness of claims 1-14

The Office Action rejects claims 1-14 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Streetprices in view of *Chung et al.* (U.S. Patent No. 6,738,767). This rejection is respectfully traversed.

Streetprices does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Streetprices actually teaches away from the presently claimed invention because it teaches a Web site embodied and executed on a Web server, as opposed to a method that is performed in a client computer, as in the presently claimed invention. In fact, the streetprices.com Web site includes advertisements, as evidenced by the applied references. Certainly, by providing a server-based Web site, the streetrpices.com service wants client computers to visit the Web site so that the customer sees the advertisements. Thus, the server-based streetprices.com Web site would not lead a person of ordinary skill in the art to perform similar functions on a client, because there would be no server to control the distribution of, and exposure to, advertisements.

Chung does not make up for the deficiencies of the Streetprices.com references. While parsing markup language documents and, more particularly, site templates may be generally known in the art, as evidenced by the use of site templates to discover schematic structure in HTML documents in *Chung*, there is no suggestion in the prior art to use site templates to parse data at a **client** computer and generate, at the **client** computer, a data record including a product name and price. Absent the Office Action pointing out some teaching or incentive to implement Streetprices on a client computer, one of ordinary skill in the art would not be led to modify Streetprices to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify Streetprices in this manner, the presently claimed invention can be reached only through an improper use of hindsight using Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

The Office Action rejects claims 1-14 under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Bailey* in view of *Chung*. This rejection is respectfully traversed. *Bailey* does not explicitly or inherently teach the features of the presently claimed invention and, thus, does not anticipate the claimed invention.

Bailey suffers from the same deficiencies as the Streetprices.com references. *Bailey* teaches a web site that is embodied on a server. *Bailey* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Bailey* actually teaches away from the presently claimed invention because it teaches a Web site embodied and executed on a Web server, as opposed to a method that is performed in a client computer, as in the presently claimed invention.

Chung does not make up for the deficiencies of the *Bailey*. While parsing markup language documents and, more particularly, site templates may be generally known in the art, as evidenced by the use of site templates to discover schematic structure in HTML documents in *Chung*, there is no suggestion in the prior art to use site templates to parse data at a **client** computer and generate, at the **client** computer, a data record including a product name and price. Absent the Office Action pointing out some teaching or incentive to implement the functionality taught by *Bailey* on a client computer, one of ordinary skill in the art would not be led to modify *Bailey* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Bailey* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

In addition, the *Chung* patent and the instant application were, at the time of the invention was made, owned by, or subject to an obligation of assignment to the same person. 35 U.S.C. § 103(c) states:

> (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The instant application was filed on or after November 29, 1999. The *Chung* patent qualifies as prior art only under 35 U.S.C. § 102(e). And, the instant application

and the *Chung* patent were commonly owned or subject to an obligation of assignment to the same person at the time the invention was made. Therefore, the *Chung* patent cannot be used in a 35 U.S.C. § 103 rejection to preclude patentability. As such, the rejections are improper and should be withdrawn.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-14 under 35 U.S.C. § 103(a).

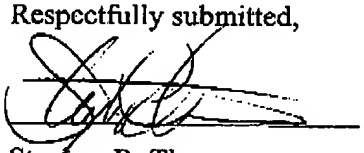
VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: March 16, 2005

Respectfully submitted,



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